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GOODWIN PROCTER LLP
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EXAMINER

LANDSMAN, ROBERT S

ART UNIT	PAPER NUMBER
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1647

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte AVI J. ASHKENAZI, KEVIN P. BAKER, DAVID BOTSTEIN,
LUC DESNOYERS, DAN L. EATON, NAPOLEONE FERRARA,
SHERMAN FONG, HANSPETER GERBER, MARY E. GERRITSEN,
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TIMOTHY A. STEWART, DANIEL TUMAS, COLIN K. WATANABE,
P. MICKEY WILLIAMS, WILLIAM I. WOOD, and ZEMIN ZHANG

Application No. 09/993,604
Technology Center 1600

Mailed: February 19, 2009

Before CAROLYN L. JOHNSON, *Supervisory Paralegal Specialist*.
JOHNSON, *Supervisory Paralegal Specialist*.

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was electronically received by the Board of Patent Appeals and Interferences on August 14, 2008. A review of the application

revealed that it is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the Examiner to address the following matter(s) requiring attention prior to docketing.

APPEAL BRIEF, SUMMARY OF CLAIMED SUBJECT MATTER

Appellant filed an Appeal Brief dated March 18, 2008. The Appeal Brief is not in compliance with 37 C.F.R. § 41.37(c) effective September 13, 2004.

According to 37 C.F.R. § 41.37(c) (v), an Appeal Brief must include the following:

(v) *Summary Of Claimed Subject Matter*. A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which must refer to the specification by page and line number, and to the drawing, if any, by reference characters. While reference to page and line number of the specification requires somewhat more detail than simply summarizing the invention, it is considered important to enable the Board to more quickly determine where the claimed subject matter is described in the application. For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of 37 CFR 41.37(c)(1)(vii), every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

The “Summary of claimed subject matter” appearing on pages 3 and 4 of the Appeal Brief filed March 18, 2008 is deficient because it does not separately map independent claims 119 and 124 to the specification.

Correction is required.

MPEP § 1205.03 states in part:

(B) When the Office holds the brief to be defective solely due to appellant’s failure to provide a summary of the claimed subject matter as required by 37 CFR 41.37(c)(1)(v), an entire new brief need not, and should not, be filed. Rather, a paper providing a summary of the claimed subject matter as required by 37 CFR 41.37(c)(1)(v) will suffice. Failure to timely respond to the Office’s requirement will result in dismissal of the appeal. See MPEP § 1215.04 and § 711.02(b).

INCORRECT CLAIMS APPENDIX

Claims 120-123 in Appellants’ Claims Appendix depend from claim 39, which is not on appeal.

Correction is required.

EXAMINER’S ANSWER, EVIDENCE RELIED UPON

Section § 1207.02 of the *Manual of Patent Examining Procedure* (MPEP) (8th ed., Rev. 6, September 2007) states:

(A) CONTENT REQUIREMENTS FOR EXAMINER’S ANSWER. The examiner’s answer is required to include, under appropriate headings, in the order indicated, the following items:

....

- (8) Evidence Relied Upon. A listing of the evidence relied on (e.g., patents, publications, admitted prior art), and in the case of nonpatent references, the relevant page or pages.

The Examiner's Answer mailed April 14, 2008 is deficient because the "Evidence Relied Upon" section fails to include the Baker reference cited on page 6 in the Examiner's Answer's grounds of rejection of claims 119-126 and 129-131 under 35 USC § 102(b).

Appropriate correction is required.

EXAMINER'S CONSIDERATION OF REPLY BRIEF

Appellant filed a Reply Brief on June 16, 2008. There is no indication on the record indicating that the Examiner has considered the above Reply Brief.

CONCLUSION

Accordingly, it is

ORDERED that the application is returned to the Examiner to:

(1) hold the Appeal Brief filed March 18, 2008 defective, as required by 37 C.F.R. § 41.37(d);

(2) notify the Appellants to submit a "paper" which corrects the Appeal Brief's Summary of Claimed Subject Matter under 37 C.F.R. § 41.37(c)(1)(v);

(3) acknowledge and consider any “paper” submitted by Appellant to correct the Appeal Brief;

(4) notify Appellants to submit a corrected Claims Appendix to correct the dependency of claims 120-123;

(5) issue a PTO-90 citing the missing Baker references listed under the Evidence Relied Upon section, paragraph (8);

(6) consider the Reply Brief filed June 16, 2008 as indicated above; and

(7) for such further action as may be appropriate.

If there are any questions pertaining to this Order, please contact the Board of Patent Appeals and Interferences at 571-272-9797.

KZ/clj

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